

The opinion in support of the decision being entered
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT J. MENENDEZ

Appeal 2007-3382
Application 10/040,288¹
Technology Center 2600

Decided: August 14, 2007

Before JAMES D. THOMAS, JOSEPH F. RUGGIERO, and
JOSEPH L. DIXON, *Administrative Patent Judges*.
DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the
Examiner's Final Rejection of claims 1-31.

We AFFIRM.

¹ Application for patent filed October 25, 2001, entitled "System for
Monitoring a Service Vehicle."

BACKGROUND

Appellant's invention relates to a system for monitoring a service vehicle. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A service vehicle for making service calls at a plurality of locations, the service vehicle comprising:
 - a position determination device;
 - a subsystem indicator indicating a condition of a subsystem of the service vehicle;
 - an associated mobile communication device; and
 - a hub in permanent communication with a central computer, the hub communicating with the position determination device, the subsystem indicator, and the mobile communication device.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Saunders	US 5,918,172	Jun. 29, 1999
Flick (Flick '946)	US 6,703,946 B2	Mar. 9, 2004
(CIP of application 09/859,727 filed May 17, 2001)		

REJECTIONS

Claims 1-3, 5-7, 12, 16-18, 20-22, and 27 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Flick '946. Claims 4, 8-9, 13-15, 19, 23-24, and 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Flick '946. Claims 10-11, 25-26, and 31 stand rejected

under 35 U.S.C. § 103(a) as being unpatentable over Flick '946 in view of Saunders.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellant regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Jun. 3, 2005) for the reasoning in support of the rejections, and to Appellant's Brief (filed Feb. 25, 2005) and Reply Brief (filed Aug. 3, 2005) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellant's Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellant and the Examiner. As a consequence of our review, we make the determinations that follow.

At the outset, we note that Appellant's Brief is non-compliant in its content under 37 C.F.R. § 41.37(c)(1)(v) for the Summary of the Invention. Rather than remand the application at this late stage, we will decide the appeal on its merits.

ANTICIPATION

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the

claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

“It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.” *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002) (citations and internal quotation marks omitted). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (citations and internal quotation marks omitted).

Here, Appellant has not presented argument as to the deficiencies of any of the prior art teachings in a comparison to the language of the independent claims on appeal. Therefore, we find that the invention is taught by the teachings of Flick ‘946. Appellant’s sole contention is that the Flick ‘946 reference does not qualify as prior art under 35 U.S.C. § 102(e) since the application was filed, as a CIP application, after the filing date of the instant application (Br. 5-6 Reply Br. 2).

The Examiner maintains that Flick '946 teaches or fairly suggests the invention recited in independent claims 1, 16, and 31 (Answer 3-7). Appellant has not challenged the Examiner's correlation of the disclosed elements to the claimed elements. Moreover, the Examiner identifies that the teachings of Flick '946 upon which the Examiner relied upon in the statement of the rejection can additionally be found in the priority document 09/859,727 originally filed on May 17, 2001, (which is prior to Appellant's filing date) and which is now US Patent 6,512,465, which entitles those same teachings in Flick '946 to the earlier priority date (Answer 8-9). We agree with the Examiner that all the material relied upon in the anticipation rejection has substantially corresponding subject matter disclosure in the priority document. Therefore, we find that the Flick '964 reference, for the relied upon subject matter, is entitled to at least the original filing date of May 17, 2001. Since the date of May 17, 2001, is prior to Appellant's filing date, we find that Flick '964 qualifies as prior art under 35 U.S.C. § 102(e) as applied by the Examiner.

We find the Examiner's reliance upon Flick '465 to evidence the entitlement of Flick '964 to the earlier filing date from the CIP filing for the subject matter relied upon by the Examiner is proper. Additionally, the Examiner would have been correct to rely upon the teachings of Flick '465 in a prior art rejection which clearly has a good date under 35 U.S.C. § 102(e) and the same requisite teachings as applied. Therefore, we will sustain the rejection of independent claims 1 and 16 under 35 U.S.C. § 102 and their corresponding dependent claims.

OBVIOUSNESS

Since Appellant has set forth no separate arguments for patentability under 35 U.S.C. § 103(a) for independent claim 31 and dependent claims 4, 8-11, 13-15, 19, 23-26, and 28-30, we will sustain the rejection under 35 U.S.C. § 103(a).

CONCLUSION

To summarize, we have sustained the rejection of claims 1-3, 5-7, 12, 16-18, 20-22, and 27 under 35 U.S.C. § 102, and we have sustained the rejection of claims 4, 8-11, 13-15, 19, 23-26, and 28-31 under 35 U.S.C. § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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